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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,849	01/12/2004	Walter M. Bain	1311.APT.CI	8439

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,849

Applicant(s)

BAIN, WALTER M.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/19/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 60-67, 69-92 and 94-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265).

Williams discloses a semi-automated pharmacy for filling prescriptions for customers with a will call area (380) (see col. 10, lines 48-53) in which finished prescriptions are kept for customers. Williams further discloses a computer (104) for inputting customer data and prescription data.

Williams does not expressly disclose, but Schlamp discloses a dispenser placed in a wall, for holding items such as filled prescriptions, for customers with access to a particular bin by the customers on one side of the wall and access to a particular bin by the pharmacist to load a customer's prescription on the other side of the wall.

Both Williams and Schlamp are considered analogous art because they both concern article handling, and in particular, Williams concerns filling and storing prescriptions for customers while Schlamp discloses holding finished items for customers. See Schlamp, figures 1 and 2 and col. 1, line 55-col. 2 line 46 and col. 6, lines 29-60.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Schlamp's "will call" device to Williams pharmacy, said device allowing the loading of finished prescriptions into a merchant side of the system and allowing customer pickup of the finished prescription on the other side of the "will call" device, the "will call" device located in a wall between the secure pharmacy prescription filling area and an unsecure customer pickup area on the other side of a wall.

As suggested by Schlamp, one ordinarily skilled would have been motivated to use Schlamp's device in Williams' pharmacy to reduce storage area, reduce the distance required by the pharmacist to reach system, to secure the filled prescriptions while allowing access by customers to their prescriptions after hours, and to provide for cooling/refrigeration of the unit. See Schlamp, col. 2, lines 4-44.

3. Claims 68 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al view of Schlamp and further in view of Liff et al (US 5,713,485). Williams and Schlamp disclose the system described above. Williams does not expressly disclose, but Liff discloses billing a third party insurance provider for the prescription. See Liff at col. 4, lines 35, 36 and col. 9, lines 12-19.

Both Liff and Williams are considered analogous art because they both concern pharmaceutical delivery systems.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have charged a third-party healthcare provider in Williams' pharmacy, as taught by Liff.

The suggestion/motivation would have been to allow customers to pay for prescriptions through standard well-known third-party insurance providers.

4. Claims 60-67, 69-92 and 94-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lion (US 6,330,491 B1) in view of Lion (US 5,838,575).

Lion discloses an automated pharmacy dispensing system (10) for filling prescriptions for customers with a will call area (16) in the form of an automated dispensing assembly, in which finished prescriptions are kept for customers. See Lion '491 at figure 1. Lion further discloses a computer (30) for inputting customer data and prescription data. Lion also discloses in col. 2, line 66 – col. 3, line 4, that the dispensing system may be located at any available wall space.

Lion '491 does not expressly disclose, but Lion '575 discloses the particulars of automatically filling unique prescriptions for customers. Note that the system of Lion '491 is described as dispensing prescriptions in accordance with Lion '575 at col. 5, lines 1-8.

Both Lion '491 and Lion '575 are considered analogous art because they both concern article handling, Lion '491 makes reference to use of the teachings of Lion '575.

At the time of the invention, it would have been obvious to one of ordinary skill in the art that Lion's dispensing device can be used in place of a will-call facility of a pharmacy to allow 24-hour customer access to prescription drugs. See Lion '491 at col. 1, lines 40-47.

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Further motivation would have been found in replacing pharmacists required to fill prescriptions, since the prescription filling is performed automatically. Lion '491, abstract.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (571)272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jeffrey A. Shapiro
Examiner
Art Unit 3653

July 10, 2005



DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600